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EXAMINER
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ZUKANOVICH, BRANDY A

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* MAODE MAO

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Appeal 2015-007975  
Application 14/229,801<sup>1</sup>  
Technology Center 3600

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Before HUBERT C. LORIN, BRUCE T. WIEDER, and  
KENNETH G. SCHOPFER, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Maode Mao (Appellant) seeks our review under 35 U.S.C. § 134 of the final rejection of claims 1–4, 6–8, 10–12, and 16–20. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF DECISION

We AFFIRM.

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<sup>1</sup> The Appellant identifies eBay Inc. as the real party in interest. App. Br. 2.

## THE INVENTION

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A method, comprising:

receiving a user selection of a mode from a plurality of product operational modes;

presenting separate lists of product models and product model accessories based on the mode;

receiving a user selection of a product model combination including a product model from the list of product models and at least one product accessory model from the list of product accessory models;

retrieving a list of product combinations, based on the selected product model combination, each product combination including a product supplied from one of a plurality of product suppliers and at least one product accessory supplied from one of a plurality of product accessory suppliers;

ranking the list of product combinations based on a combination value of a product score of the product and a product accessory score of the at least one product accessory in each product combination, the product score and the product accessory score given by users or reviewers; and

causing a presentation of the list of product combinations to a user via a display on a machine.

## THE REJECTIONS

The following rejections are before us for review:

1. Claims 2–4, 12, 14, and 15 are rejected under 35 U.S.C. § 112(d) or pre-AIA 35 U.S.C. § 112, 4th paragraph, as being of improper dependent form for failing to further limit the subject matter of the

claim upon which it depends, or for failing to include all the limitations of the claim upon which it depends.

2. Claims 1–4, 6–8, 10–12, and 16–20 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

### ISSUES

Did the Examiner err in rejecting claims 2–4, 12, 14 and 15 under 35 U.S.C. § 112(d) or pre-AIA 35 U.S.C. § 112, 4th paragraph, as being of improper dependent form for failing to further limit the subject matter of the claim upon which it depends, or for failing to include all the limitations of the claim upon which it depends?

Did the Examiner err in rejecting claims 1–4, 6–8, 10–12, and 16–20 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter?

### ANALYSIS

*The rejection of claims 2–4, 12, 14 and 15 under 35 U.S.C. § 112(d) or pre-AIA 35 U.S.C. § 112, 4th paragraph, as being of improper dependent form for failing to further limit the subject matter of the claim upon which it depends, or for failing to include all the limitations of the claim upon which it depends.*

The Examiner finds that claim 2 does not limit claim 1 because it calls for “[t]he combination value is a sum value of the product score of the product and the product accessory score of the product accessory.” Ans. 5. We do not understand the problem. Claim 1 calls for ranking based on a combination value of product and the product accessory scores. Claim 2 further limits that value to “comprise[] a sum value of the product score of

the product and the product accessory score of the at least one product accessory.”

Claims 3 and 4 are rejected because only a “user gives a review in claim 3 and a reviewer giving the review in claim 4.” Ans. 6. But claim 1, on which claims 3 and 4 depend, calls for “score[s] given by users *or* reviewers.” (Emphasis added.)

Accordingly, we do not sustain the rejection of claims 2–4.

Apparently, claims 12 and claims 14 and 15 are rejected for the same reasons used to reject claims 2 and claims 3 and 4, respectively. For the same reasons, we do not sustain the rejection of claimsd 12, 14 and 15.

*The rejection of claims 1–4, 6–8, 10–12, and 16–20 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.*

The Appellant argued these claims as a group. *See* App. Br. 8–20 and Reply Br. 4–7. We select claim 1 as the representative claim for this group, and the remaining claims 2–4, 6–8, 10–12, and 16–20 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(iv).

The Appellant’s challenge to the rejection is flawed. For example:

independent method claim 1 recites a machine with specific display elements, user interface features and user interactions with said features that pass the “machine-or-transformation” test because they tie the method to “a particular machine or apparatus” e.g., specific user interfaces and displays. Accordingly, the method claims, as presented herein set forth a statutory process under 35 U.S.C. 101. *See* “2014 Interim Guidance on Patent Subject Matter Eligibility”, Federal Register / Vol. 79, No. 241 / Tuesday, December 16, 2014 / Rules and Regulations.

App. Br. 19. Here is another example: “the claims provide an improvement to the functioning of the computer by providing []a specific custom user interface (e.g., user interactions, user reviews, display most relevant information to user in limited display space) for human-computer interaction, in the context of online product recommendations.” Reply Br. 5. These are examples of the many statements made in the briefs construing claim 1 as being directed to a “specific user interface” (Reply Br. 5).

However, claim 1 is not directed to a user interface. No user interface is mentioned in the claim. No step in the method claimed – apart from the last post-solution displaying step – is attached to a device, not even a computer, let alone an interface, customized or otherwise.

The claimed method is devoid of apparatus or transformational limitations. A good case can be made that the claimed method amounts to a mental process. “[M]ental processes—or processes of human thinking—standing alone are not patentable even if they have practical application” *In re Comiskey*, 554 F.3d 967, 979 (Fed. Cir. 2009). “[M]ental processes are not patent-eligible subject matter because the ‘application of [only] human intelligence to the solution of practical problems is no more than a claim to a fundamental principle.’” *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1371 (Fed. Cir. 2011).

Be that as it may, a reasonably broad construction of the claim is a prerequisite for determining whether claimed subject matter is judicially-excepted from patent eligibility under § 101 via the two-step framework identified in *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347 (2014). “The § 101 inquiry must focus on the language of the Asserted Claims

themselves.” *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1149 (Fed. Cir. 2016). *See Accenture Global Servs., GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1345 (Fed. Cir. 2013) (admonishing that “the important inquiry for a § 101 analysis is to look to the claim”); *see also Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat’l Ass’n*, 776 F.3d 1343, 1346 (Fed. Cir. 2014) (“We focus here on whether the claims of the asserted patents fall within the excluded category of abstract ideas.”).

Here, the Examiner reasonably broadly construed claim 1 in determining that claim 1 is directed to “recommending products.” Final Act. 5. In rebuttal, the Appellant did not reasonably broadly construe the claim. The incorrect reading of claim 1 as covering an interface substantively undermines the Appellant’s position, clouding the remaining arguments. For that reason alone, the Appellant’s arguments that claim 1 is not directed to an abstract idea (App. Br. 14–16) and, even if directed to an abstract idea, contains an inventive concept sufficient to transform the claimed abstract idea into a patent-eligible application (App. Br. 16–20), are unpersuasive as to error in the rejection.

The remaining arguments (App. Br. 8–14) criticizing the Examiner’s position are legally unfounded.

According to *Alice* step one, “[w]e must first determine whether the claims at issue are directed to a patent-ineligible concept,” such as an abstract idea. *Alice*, 134 S. Ct. at 2355.

The “directed to” inquiry applies a stage-one filter to claims, considered in light of the specification, based on whether “their character as a whole is directed to excluded subject matter.” *Internet Patents Corp. v.*

*Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015); *see Genetic Techs. Ltd. v. Merial L.L.C.*, 818 F.3d 1369, 1375 (Fed. Cir. 2016) (inquiring into “the focus of the claimed advance over the prior art”).” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016). “The ‘abstract idea’ step of the inquiry calls upon us to look at the ‘focus of the claimed advance over the prior art’ to determine if the claim’s ‘character as a whole’ is directed to excluded subject matter.” *Affinity Labs of Texas v. DIRECTTV, LLC*, 838 F.3d 1253, 1257 (Fed. Cir. 2016) (quoting *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016). “In determining the eligibility of respondents’ claimed process for patent protection under § 101, their claims must be considered as a whole.” *Diamond v. Diehr*, 450 U.S. 175, 188 (1981).

Claim 1 sets out 6 steps such that (1) a selected mode is received; (2) two model lists are presented; (3) a selected combination from the model lists is received; (4) a list of product combinations is retrieved; (5) the product combinations are ranked; and (6) a list of product combinations are presented. Claim 1 as whole, as the Examiner fairly determined, is directed to “recommending products.”

The Specification’s discussion of the problem and the solution supports that determination. According to para. 2, “[t]he present application relates generally to information processing and particularly, but not by way of limitation, to systems and methods to facilitate users in product shopping over a network.” In that regard, the problem is that “in many situations, sellers may not provide buyers with efficient or convenient approaches to finding products that are attractive to buyers.” Para. 3. As an example, “it



could be time consuming for a buyer to find a satisfactory camera model that meets her interests without professional suggestions.” Para. 14. The solution is to use photos taken by different camera models and rank them. “The ranked list of photos may facilitate the buyer in evaluating the candidate camera model.” Para. 14.

Accordingly, we see no legal difficulty with the Examiner’s determination that claim 1 is directed to “recommending products.” Nor do we see any legal difficulty in characterizing “recommending products” as an abstract idea. *Cf. Personalized Media Commc’ns, LLC v. Amazon.Com, Inc.*, 161 F.Supp.3d 325, 337 (D.Del. 2015), *aff’d*, 2016 WL 7118532 (Mem) (Fed. Cir. 2016) (“providing personalized recommendations” is an abstract idea). The Appellant focuses a great deal of attention on the claimed ranking step but ranking *per se* is an abstract idea. *Cf. SmartGene, Inc. v. Advanced Biological Labs., SA*, 555 F. App’x 950 (Fed. Cir. 2014), *cert. denied*, 135 S. Ct. 58 (2014) (*see* claim 1 of US 6,081,786). Even if the directed to inquiry reached the determination that claim 1 was instead directed to ranking, that would not change the determination that claim 1 is directed to an abstract idea. To the extent the Appellant would argue that the ranking step as claimed is more limited to a particular application of ranking *per se*, that does not change the determination. *See CyberSource*, 654 F.3d at 1371 (“The Court [*Parker v. Flook*, 437 U.S. 584 (1978)] rejected the notion that the recitation of a practical application for the calculation could alone make the invention patentable.”)

We now proceed to the second step. Step two is “a search for an ‘inventive concept’—*i.e.*, an element or combination of elements that is

‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’” *Alice*, 134 S. Ct. at 2355 (alteration in original) (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1294 (2012)). In that regard, we agree with the Examiner that “when considering the elements and combinations of elements, the claims as a whole, do not amount to significantly more than the abstract idea itself.” Final Act. 5. The Appellant’s arguments to the contrary are unpersuasive because they focus on limitations not in the claims, as discussed above.

For the foregoing reasons, the rejection is sustained.

#### CONCLUSIONS

The rejection of claims 2–4, 12, 14 and 15, under 35 U.S.C. § 112(d) or pre-AIA 35 U.S.C. § 112, 4th paragraph, as being of improper dependent form for failing to further limit the subject matter of the claim upon which it depends, or for failing to include all the limitations of the claim upon which it depends is reversed.

The rejection of claims 1–4, 6–8, 10–12, and 16–20 under 35 U.S.C. § 101 as being directed to non-statutory subject matter is affirmed.

#### DECISION

The decision of the Examiner to reject claims 1–4, 6–8, 10–12 and 16–20 is affirmed.

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Application 14/229,801

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED